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ICD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/610,320	07/05/00	AFRIAT	I 193022US0

022850 HM12/1102  
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EXAMINER	
BENNETT, R	
ART UNIT	PAPER NUMBER

1615  
DATE MAILED: 11/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/610,320

Applicant(s)

AFRIAT ET AL.

Examiner

Rachel M. Bennett

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1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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### **DETAILED ACTION**

The Examiner acknowledges receipt of Amendment A filed 8/24/01.

Claims 1, 3-24 are pending.

#### ***Specification***

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boothroyd et al. (US 5250289), and further in view of Tachibana et al. (US 5412004) and Schulz et al. (US 5811487).

Boothroyd discloses a sunscreen composition, which comprises a water-in-oil emulsion which comprises a) 0.5 to 30% by weight titanium dioxide, b) 5 to 20 % by weight of an oil phase, c) 1 to 15% by weight of an emulsifier, and d) at least 40% by weight of an aqueous phase. Further suncreening agents may be included. The oil phase may be a wax, natural oil, silicone oil or a mixture. Preferred emulsifiers are silicone emulsifiers such as silicone polyols. Stabilizing salts such as sodium chloride may be added (see abstract and col. 2). The resulting composition is a cream (see examples). Boothroyd fails to teach the crosslinked elastomeric organopolysiloxane.

Tachibana et al. discloses a silicone polymer, a paste-like silicone composition prepared by kneading the silicone polymer and a silicone oil under a shearing force, and a water-in-oil

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type composition comprising the paste-like silicone composition as an oil phase component (see abstract). Example 3 discloses organohydrogenpolysiloxanes and polyoxyalkylenes and solvents are processed to obtain silicone polymer particles. The paste-like silicone composition is capable of dispersing water stably and homogeneously without using a surfactant. The water-in-oil type cosmetic composition which imparts a fresh sensation upon use without stickiness and stable for a long time, and having a superior water repellency and a capability of excellently retaining the makeup with out running (see col. 2 lines 3-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the silicone polymer taught by Tachibana for the silicone emulsifiers taught by Boothroyd because of the expectations of achieving a composition which is capable of dispersing water stably and homogeneously without using a surfactant. Also, the water-in-oil cosmetic composition would impart a fresh sensation upon use without stickiness and stable for a long time, and having a superior water repellency and a capability of excellently retaining the makeup with out running as taught by Tachibana.

### ***Response to Arguments***

3. Applicant's arguments filed 8/24/01 regarding obviousness-type double patenting over copending application 09/611663 and claim 1 being rejected over 112, second paragraph have been fully considered and are found to be persuasive. Accordingly, the obviousness double patenting rejection and the 112, second paragraph rejection has been withdrawn.

4. Applicant's arguments filed 8/24/01 regarding the 103(a) rejection over claims 1-21 have been fully considered but they are not persuasive.

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Applicants argue the cited reference Boothroyd fails to suggest more than 64% of water in the water in oil composition. Thus, Boothroyd fails to suggest the independent Claim 1 limitation that "the composition comprises at least 65% water with respect to the total weight of the composition". However, the Examiner refers to Boothroyd in which the composition comprises "at least 40% by weight of an aqueous phase". Furthermore, Example 2 discloses 64% water and Examples 6-8 disclose 61-62% water with a silicone emulsifier. It is the position of the Examiner that Boothroyd teaches an essentially similar product and the Examples teach 62-64% water. Based on the teaching of the prior art, it is suggested that data showing the patentable distinction between the instant product and the prior art be submitted to determine the allowability of the claims.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel M. Bennett whose telephone number is (703) 308-8779.

The examiner can normally be reached on Monday through Friday, 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 309-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

R. Bennett:RMB  
October 31, 2001

THURMAN K. PAGE  
SUPERVISING PATENT EXAMINER  
TECHNOLOGY CENTER 1600